

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) HSJ920030262US1	
<div>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</div> <div>on _____</div> <div>Signature _____</div> <div>Typed or printed name _____</div>	<div>Application Number 10/788,953</div>		<div>Filed 02/26/2004</div>
	<div>First Named Inventor Andre S. Chan</div>		
	<div>Art Unit 2627</div>		<div>Examiner Watko, Julie Anne</div>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="margin-top: 20px;"><div style="display: flex; justify-content: space-between;"><div style="width: 45%;">I am the</div><div style="width: 50%; text-align: right;">/Thomas R. Berthold/</div></div><div style="display: flex; justify-content: space-between;"><div style="width: 45%;"><input type="checkbox"/> applicant/inventor.</div><div style="width: 50%; text-align: right;">Signature</div></div><div style="display: flex; justify-content: space-between;"><div style="width: 45%;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div><div style="width: 50%; text-align: right;">Thomas R. Berthold</div></div><div style="display: flex; justify-content: space-between;"><div style="width: 45%;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>28689</u></div><div style="width: 50%; text-align: right;">408-396-8411</div></div><div style="display: flex; justify-content: space-between;"><div style="width: 45%;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</div><div style="width: 50%; text-align: right;">Telephone number</div></div><div style="display: flex; justify-content: space-between;"><div style="width: 45%;"></div><div style="width: 50%; text-align: right;">01/04/2007</div></div><div style="display: flex; justify-content: space-between;"><div style="width: 45%;"></div><div style="width: 50%; text-align: right;">Date</div></div></div>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<div><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</div>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/788,953

Art Unit: 2627

Filing Date: 02/26/2004

Examiner: WATKO, JULIE ANN

First Named Inventor: Andre S. Chan

Date: January 4, 2007

Title: **DATA RECORDING DISK DRIVE WITH NONPLANAR PLATE SURFACES
FOR DAMPING OUT-OF-PLANE DISK VIBRATION**

Pre-Appeal Brief Request for Review

The rejection of Claim 1 under Section 102(e) as being anticipated by US 7031104 B1 (Butt et al.) is in error because an element of Applicants' invention is not disclosed in Butt.

1. A data recording disk drive comprising:
a housing;
at least one disk rotatable about an axis of rotation;
a motor attached to the housing for rotating the disk;
a plate fixed to the housing, the plate extending circumferentially around a sector of the disk and radially across a radially outer annular region of the disk, the plate having a substantially planar surface facing a disk surface, said plate surface having a plurality of discrete surface features arranged in a pattern of radially-spaced concentric rings, ***each ring comprising a plurality of discrete circumferentially spaced-apart surface features.***

The element not disclosed by Butt et al. is the above bold-italicized portion, and is also shown in Fig. 6 (Exhibit A attached) as "circumferentially spaced-apart surface features" 306 in each of the "radially-spaced concentric rings".

The erroneous application of Butt et al. is stated below from the Advisory Action, wherein the bold-italicized portion is the objectionable interpretation.

Butt et al explicitly teach "channels 204 concentrated in one or more portions of an inner surface of the base" (see col. 8, lines 20-21). Butt et al further teach "channels 204 concentrated in one or more portions of the inner surface of the base 180" (see col. 8, lines 60-64). It is clear that such "portions" are circumferentially spaced apart portions, insofar as ***Butt et al show that a "plurality of arcuate channels 158 are located upstream of the actuator arm 50" (see col. 7, lines 32-33), that "channels 158 are located downstream of the actuator arm 50" (see col. 7, lines 33- 34), and that "channels 158 are located roughly midway between the upstream side of the actuator***

arm 50 and the downstream side of the actuator arm 50" (see col. 7, lines 35-37). The Examiner believes that these teachings together would fairly result in anticipation of the new limitation in independent claim 1 .

The above bold-italicized portion refers to “channels 158”, which are shown in Fig. 5D of Butt et al. (Exhibit B attached). The objectionable interpretation of Butt et al. is that channels 158 are located in three discrete circumferential locations, thereby apparently reading on Applicants’ “discrete circumferentially spaced-apart surface features”. However, Butt et al. teaches that these are three distinct alternative embodiments. In col. 7, lines 29-37, Butt et al. states:

In *one embodiment*, the plurality of arcuate channels 158 are on the cover 150 so that when the cover 150 is affixed to the base 30, the plurality of arcuate channels 158 are located upstream of the actuator arm 50. *In other embodiments*, the channels 158 are located downstream of the actuator arm 50. *In another embodiment*, the channels 158 are located roughly midway between the upstream side of the actuator arm 50 and the downstream side of the actuator arm 50.

The above bold-italicized portions are omitted from the quotation of Butt et al. that appears in the Advisory Action. Thus the rejection is based on combining a single feature from three distinct alternative embodiments of Butt et al.. Butt et al. does not teach or suggest such a combination. Rather, Butt shows in every figure that shows the channels (Figs 3-6) that each channel is a single continuous arcuate channel.

This erroneous interpretation of Butt et al. is made clear by the following statement in the Advisory Action, which is apparently the basis for combining the three distinct alternative embodiments to arrive at “circumferential spaced-apart” arcuate channels:

Butt et al explicitly teach "channels 204 concentrated in one or more portions of an inner surface of the base" (see col. 8, lines 20-21). ... It is clear that such "portions" are circumferentially spaced apart portions ...

Actually, it is clear that the “one or more portions” referred to in Butt et al. are *not circumferentially* spaced apart portions. Rather, it is clear that they are *radially* spaced-apart portions. The quoted language from Butt et al. (col. 8, lines 20-21) refers to Fig. 5A. Fig. 5A has an “outer portion 94” and a “middle portion 98” (col. 5, line 63 to col. 6, line 7). These are

clearly *radial* portions. Thus, there is no basis for asserting that Butt et al. teaches one or more circumferentially spaced apart portions.

The Section 102(e) rejection further states:

However, even if these teachings together did not result in anticipation of independent claim 1, there would be no invention in relocating known parts, when the operation of the apparatus were not modified by the relocation.

This maxim is not applicable here. The “parts” of Butt et al. are radially-spaced continuous arcuate channels. Just where did Applicants relocate these “parts”. It is clear that there is no relocation of arcuate channels because Applicants’ “parts” are rings, with each ring being “discrete circumferentially spaced-apart surface features”. The maxim can only be applied by relying on the above erroneous interpretation of Butt et al., namely that each arcuate channel is actually a plurality of circumferentially-spaced arcuate channels.

January 4, 2007

Respectfully submitted,

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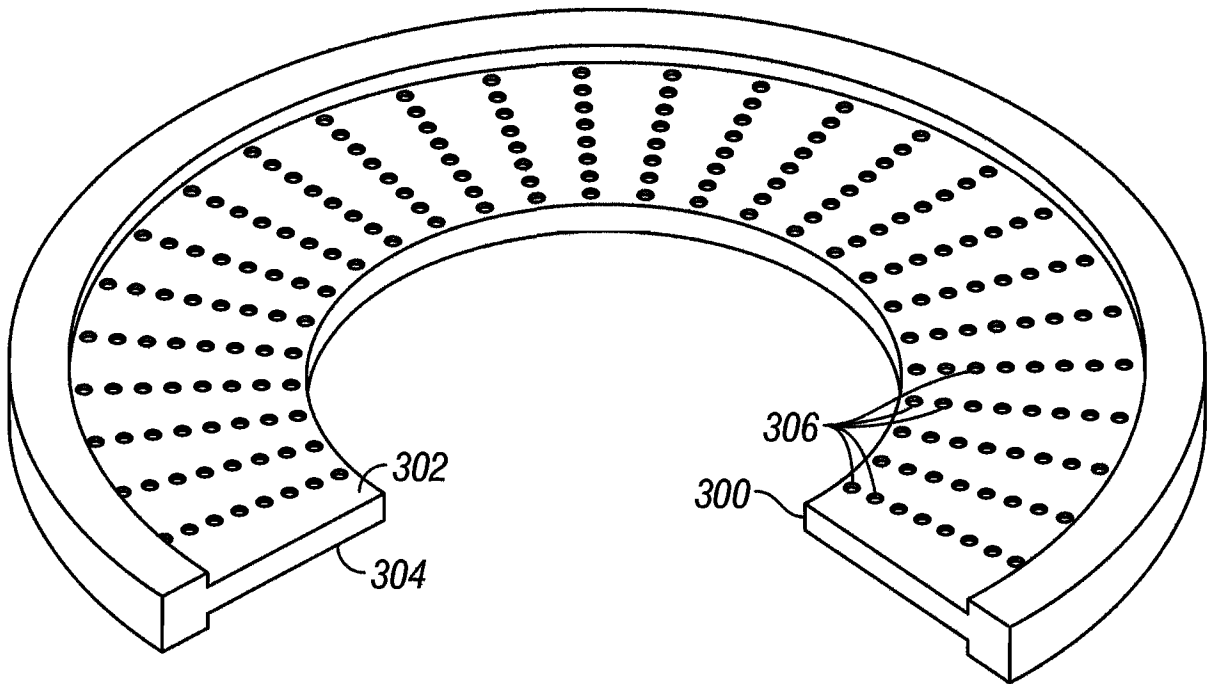


FIG. 6A

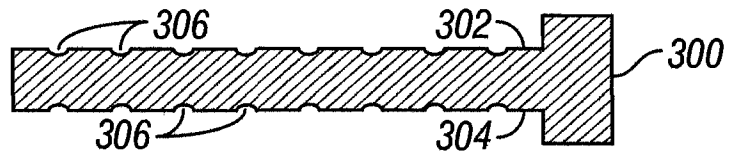


FIG. 6B

Exhibit A

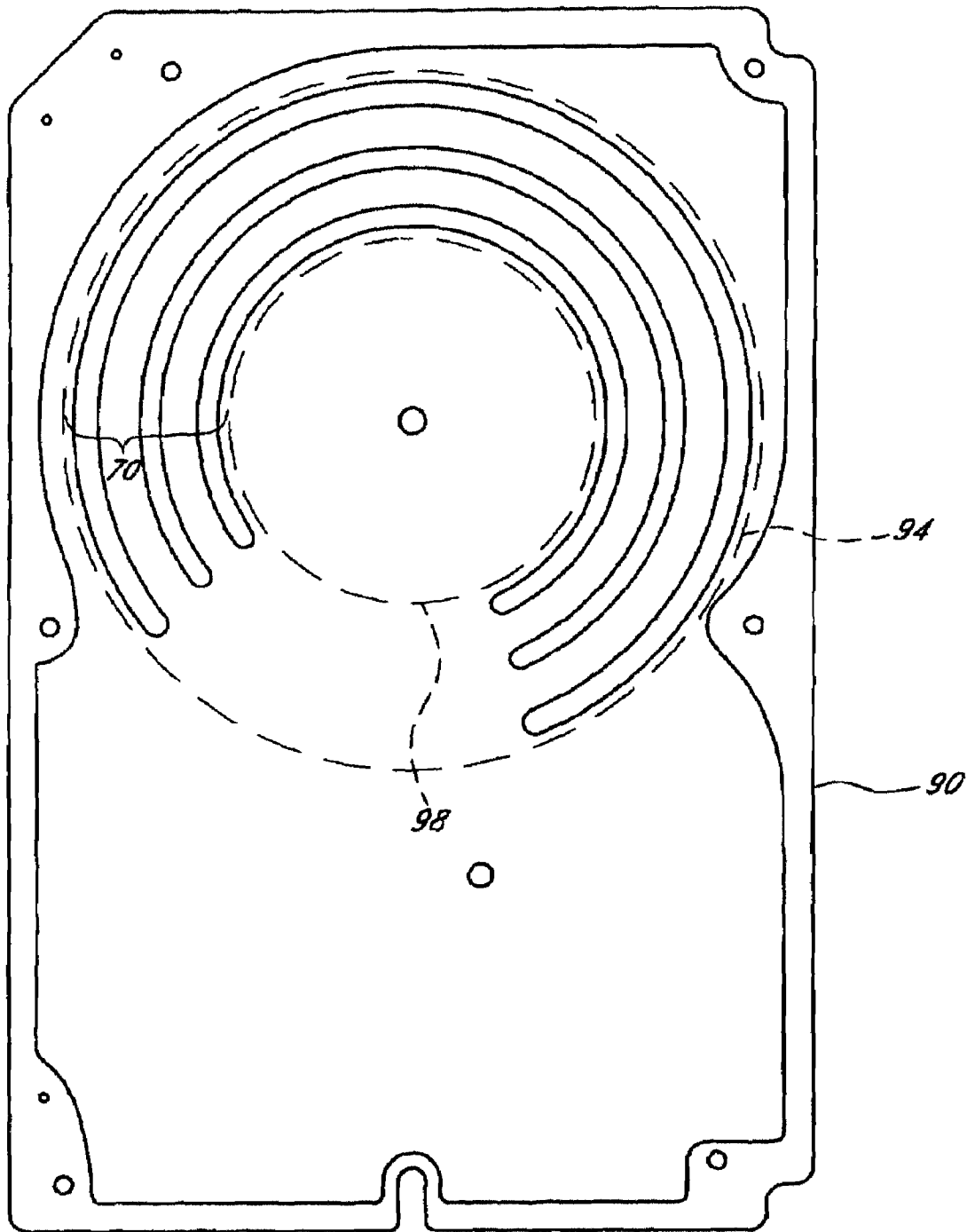


FIG. 5A

Exhibit B